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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,701	05/05/2005	Thomas J. Nosker	OCIRS 3.3-077	7140

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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
MULLIS, JEFFREY C	
ART UNIT	**PAPER NUMBER**
1711	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/501,701	NOSKER ET AL.	
	Examiner	Art Unit	
	Jeffrey C. Mullis	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 8/24-05; 5-26-05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants melt flow lacks units and is therefore unclear. Furthermore it is not clear how a material whose melt flow cannot be measured at 190 degrees centigrade (such as a typically high melting polycarbonate) should be viewed since it cannot be determined whether or not such a material is encompassed by the claims. Lastly "melt flow can be interpreted as melt flow ratio or melt flow rate and is therefore ambiguous.

Applicants reference "BA" on their IDS of 10-24-05 was not submitted and therefore was not considered, MPEP 609.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4-12, 15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haddock (US 5,989,683).

Patentees disclose that ABS/PC blends are commercially available under the Tradenames PULSE 1370 and CYCOLOYC 1110 which has modulus in Tables 1 and 2 similar or better than applicants Tables III and VI and therefore would appear to have applicants claimed characteristics. With re to applicants "lumber" of instant claim 12, this term only appears to apply to appearance, a characteristic and is therefore assumed to be inherent in the patented material.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock, cited above.

Patentees do not disclose the use of continuous extrusion. However, applicants admit that continuous extrusion was known at the time of the invention to be useful for fabrication of thermoplastics (paragraph 22 of applicants published application). Hence use of continuous extrusion in the process of patentees would have been obvious to a practitioner having an ordinary skill in the art, motivated by the need of patentees to fabricate their thermoplastics and by a known method for fabricating thermoplastics absent any showing of uprising or unexpected results.

Claims 1, 4-19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Priedeman, JR. (US 2002/0017743).

Patentees disclose the use of a commercially available ABS/PC blend in example 2 having a melt flow of 10-20 g/10 min. While the measurement temperature is reported as 280, lowering the temperature of measurement to 190 degrees would have to lower the MFR by more than a factor of 10 and therefore the commercially available CYCOLOY reasonably appears inherently have a MFR of grater than about 1 as required by the claims. With re to applicants "lumber" of instant claim 12, this term only appears to apply to appearance, a characteristic and is therefore assumed to be inherent in the patented material. With re to "railroad tie", patentees disclose "rods" in paragraph 39 and as rods could reasonably be used to connect railroad tracks (at least toy ones), the limitations of claim 13 are met. Similarly, marine pilings are often tubular as are rods. Continuous extrusion is disclosed in paragraph 22.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1, 3, 8, 9, 11, 12, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Farah (WO 96/07703).

Farah discloses a composition which may contain ethylene polymers having a melt flow of 0.01 g/10 min (page 9, lines 28-30) which is combined with polycarbonate having a melt flow rate of 3-150 (page 6, lines 28-35), which, while measured at a higher temperature has substantially higher flow rate and would therefore reasonably have applicants flow rate at 190 degrees centigrade.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farah, cited above in view of March (US 5,937,521) or Bayer (US 6,001,491).

March discloses that plastics may be converted to marine pilings (abstract) while March discloses production of either marine pilings or railroad ties from plastics (column 7, lines 29-40).

The examiner may be incorrect re the materials of patentees having applicants melt flow rates for all embodiments but to be certain applicants polyethylene flow rates are explicitly disclosed and patentees lowest molecular weight polycarbonate is very low molecular weight with flow rate of 150 explicitly disclosed and there therefore appears little doubt that materials with applicants characteristic melt flow rates can be used by patentees. Also while no examples exist in the patent using applicants combination of

materials exist (assuming that picking and choosing from patentees' ranges of MFR is needed and combining such disclosures due to the fact that of patentees' two MFR ranges, neither one is entirely encompassed by the claimed MFR range), selection of applicants features by choosing from the various disclosures of the patent and combining them would have been obvious to a practitioner having an ordinary skill In the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results. While patentees do not disclose the production of rail road ties or pilings.

With re to production of marine pilings or railroad ties production of such from the composition of the primary reference would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in view of the secondary references motivated to increase the usefulness of Farahs' product absent any showing of surprising or unexpected result.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sperk (US 5,334,647) in view of March (US 5,937,521) or Bayer (US 6,001,491)..

Patentees disclose a composition having a high viscosity component and a low viscosity component with the difference in viscosities may be as much as a factor of 100 (column 3, lines 49-67). The components may include applicants polymers in patent claim 11. Ultrahigh molecular weight polyethylene may be used at column 12, lines 20-25, a material those skilled in the art would assume would be encompassed by applicants MFR while the MFR of the polycarbonate may be 60 at column 9, lines 15-20. The components are immiscible at column 2, lines 25-30. The material may be

injection molded at the paragraph bridging columns 14 and 15. While no specific examples with all of applicants features in combination are present in the patent , choice of such by selecting from the various disclosures of the patent would have been obvious to a practitioner having an ordinary skill in the art a t the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

With re to production of marine pilings or railroad ties production of such from the composition of the primary reference would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in view of the secondary references motivated to increase the usefulness of Sperks' product absent any showing of surprising or unexpected result.

US 2007/0082995 and 2002/0099160 cited of interest disclose MFR data at paragraphs 92 and 158 respectively for various polycarbonates.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1711

JCM

6-21-07

Jeffrey Mullis
Primary Examiner
Art Unit 1711